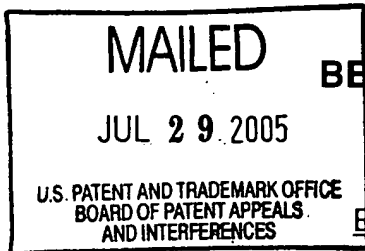


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE



**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JENNIFER NEWNAM, SCOTT NEWNAM,
and IZET FRAANJE

Appeal No. 2005-0697
Application No. 09/536,518

ON BRIEF

Before RUGGIERO, DIXON, and GROSS, Administrative Patent Judges.
RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the Examiner's rejection of claims 1-16, which are all of the claims pending in the present application. Claims 17 and 18 have been canceled.

The claimed invention relates to a method for using a communication network to enable multiple users to compete in a skill-based contest. Contestants are identified, grouped into subsets, and matched into subcompetitions. Responses to the subcompetition task are monitored and a subcompetition outcome status of each

contestant is determined. The contest begins for all contestants at a fixed start time and converges to a unique winner in a fixed amount of time.

Claim 1 is illustrative of the invention and reads as follows:

1. A method of using a communication network so that a large multitude of users may simultaneously compete in a skill-based contest as contestants, comprising:
 - a. identifying a large multitude of contestants;
 - b. grouping the contestants into group subsets according to group criteria;
 - c. matching contestants within the group subsets into subcompetitions;
 - d. for each subcompetition, presenting a competition task over the communication network to the contestants of the subcompetitions;
 - e. monitoring responses to the competition task from each subcompetition and determining a subcompetition outcome status of each contestant in the subcompetition;
 - f. grouping at least some of the contestants according to at least one of the group criteria or subcompetition outcome status;
 - g. repeating acts (c)-(f) until there is a unique winner of the contest wherein the contest begins for all contestants at a fixed start time and converges to the unique winner in a fixed, short amount of time after the fixed start time.

The Examiner relies on the following prior art:

"NetPlay Debuts Internet's Premier Multi-Player Entertainment Network; NetPlay Game Club Brings People Together To Create Broad-Based, Online Community" (NetPlay), DIALOG® File 810: Business Wire (March 1997).

Claims 1-16, all of the appealed claims, stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over NetPlay.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Briefs¹ and Answer for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner and the evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Briefs along with the Examiner's rationale in support of the rejection and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 1-16.

Accordingly, we reverse.

¹ The Appeal Brief was filed April 13, 2004 (Paper No. 16). In response to the Examiner's Answer mailed June 29, 2004 (Paper No. 17), a Reply Brief was filed August 30, 2004 (Paper No. 19), which was acknowledged and entered by the Examiner as indicated in the communication dated October 18, 2004 (Paper No. 20).

ordinary skill in the art the obviousness of the invention as set forth in claims 1-16.

Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to the Examiner's 35 U.S.C. § 103(a) rejection of appealed independent claim 1, Appellants assert that the Examiner has failed to establish a

prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the applied prior art reference. After reviewing the arguments of record from Appellants and the Examiner, we are in general agreement with Appellants' position as stated in the Briefs.

We find particularly compelling Appellants' arguments (Brief, pages 7 and 8) which assert that the Examiner has never addressed the explicit language of independent claim 1 which requires that the contest for all contestants begins "at a fixed start time" and produces a winner "in a fixed, short amount of time after the fixed start time." (Our emphasis). We find nothing in the NetPlay reference which would teach or suggest such a feature, nor has the Examiner provided any line of reasoning which would support the position that such a teaching exists in the reference.

We further agree with Appellants that the Examiner has improperly used Official Notice to address various features of independent claim 1 as well as several of the appealed dependent claims. While the Examiner has taken Official Notice of several claimed computer network multi-player game features, there is no evidence forthcoming from the Examiner that such features exist in the NetPlay reference relied on by the Examiner in formulating the rejection. As indicated in the reasoning provided by recent cases from our reviewing court, "[T]he Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence


61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), in which the court required evidence for the determination of unpatentability by clarifying that the principles of “common knowledge” and “common sense” may only be applied to analysis of evidence, rather than be a substitute for evidence. The court has also recently expanded their reasoning on this topic in In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002).

We are further of the view that even assuming, arguendo, that the Examiner’s asserted well known aspects of computer network multi-player games were supported by evidence, there remains no indication from the Examiner as to how the explicitly claimed features of a “fixed start time” and the convergence to a unique winner in a “fixed, short amount of time after the fixed start time” are taught or suggested by the NetPlay reference.

Accordingly, since we are of the opinion that the Examiner has not established a prima facie case of obviousness since all of the claimed limitations are not taught or suggested by the NetPlay reference, we do not sustain the rejection of independent claim 1, nor of claims 2-6 dependent thereon.

In summary, we have not sustained the Examiner’s 35 U.S.C. § 103(a) rejection of any of the claims on appeal. Therefore, the decision of the Examiner rejecting claims 1-16 is reversed.

Joseph F. Ruggiero
JOSEPH F. RUGGIERO
Administrative Patent Judge


JOSEPH L. DIXON
Administrative Patent Judge

Anita Pelman Gross
ANITA PELLMAN GROSS
Administrative Patent Judge

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Application No. 09/536,518

Page 8

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